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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,413	11/21/2003	Kenneth Nelson	513-2	3417

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EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	**PAPER NUMBER**
3688	

MAIL DATE	DELIVERY MODE
09/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/719,413	NELSON ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-12 and 14-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-12 and 14-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 6/26/2009.

2. Claims 1-3, 5-12, 14-21 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-3, 5-12 and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (6,632,992 hereinafter Hasegawa) in view of Langseth et al. (6.694,316 hereinafter Langseth) further in view of Corvin (2001/0054181 hereinafter Corvin).

With respect to claim 1, Hasegawa teaches a method for playing back a media file (Abstract). Determining a designated type associated with said digital file (i.e. determining if the media should be provided at a discount or at a regular price based if advertisements are to be appended or not appended to the music data (see Figures 7 and 8); playing back said digital media file including required advertising in accordance with said determined type of media file (the user plays the music and the advertisements accordingly)(see Figure 9 and col. 11, lines 18-24).

With respect to playing the file on an authorized playback apparatus. Langseth teaches the subscriber authorizing in which device (PDA, pager, phone etc.) he or she

wants to receive travel, news, finance, weather, sports information from (Figure 2A). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included authorizing in which device or apparatus the user wants to receive certain information in order to **provide a readily medium for delivery of the right information at the right time** (see Langseth column 3, lines 6-9).

With respect to the newly amended feature of the play back apparatus being configured to automatically replay said advertising block in response to receiving a user-command to institute a trick play operation for scanning through a time segment of the media file that is adjacent to said advertising block. Corvin teaches methods and systems for forced advertisements, **the forced advertisement play may recommence or restart if the channel is switched or if the user equipment 15 is turned on and off** (paragraph 0028). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Corvin of the play back apparatus being configured to automatically replay said advertising block in response to receiving a user-command to institute a trick play operation for scanning through a time segment of the media file that is adjacent to said advertising block in order to "**preferably facilitate preventing viewers from changing away from, or skipping, television advertisements** (Corvin, paragraph 0006).

With respect to claims 3, 12, Hasegawa teaches a method for playing back a digital file (Abstract). Defining a plurality of predetermined media types in accordance with an advertising scheme (i.e. determining if an advertisement should be appended or

not according to a variety of advertisement/discounted prices scheme)(see Figure 7 and 8); Valuing each of said plurality of predetermined media types in accordance with said advertising scheme (See figure 9 and col. 11, lines 18-24); selecting one of said plurality of media type (see figure 8); playing back said selected media type and invoking said associated advertising scheme (See Figure 11).

With respect to playing the file on an authorized playback apparatus. Langseth teaches the subscriber authorizing in which device (PDA, pager, phone etc.) he or she wants to receive travel, news, finance, weather, sports information from (Figure 2A). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included authorizing in which device or apparatus the user wants to receive certain information in order to **provide a readily medium for delivery of the right information at the right time** (see Langseth column 3, lines 6-9).

With respect to the newly amended feature of playing back said selected media type on an the proprietor authorized play back apparatus wherein said proprietor-authorized playback apparatus is configured to determine which of said plurality of playback modes is associated with the selected media type and to invoke said advertising scheme by instituting the determined forced advertising play back mode. Corvin teaches methods and systems for forced advertisements, The user equipment 15 being the authorized play back apparatus and the system determines and selects what type and when the forced advertisements is to be presented, for example an sponsor may select to forced an advertisement prior to the time at which the forced advertisement is to be presented, the forced advertisement may be received when

needed, when certain broadcast advertisements are broadcast at certain times of the day, or at certain times within a program, until the completion of the advertisement or it may replay from the beginning (paragraphs 0008, 0024 0025 and Figure 2, steps 24 and 25) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Corvin of playing back said selected media type on an the proprietor authorized play back apparatus wherein said proprietor-authorized playback apparatus is configured to determine which of said plurality of playback modes is associated with the selected media type and to invoke said advertising scheme by instituting the determined forced advertising play back mode in order to allow the sponsor to impose the different restrictions.

With respect to claims 10 and 19, Hasegawa further teaches that the media file is provided on a removable storage medium (i.e. external storage unit 17a may be a floppy disk, CDS or DVD)(see Figure 2).

With respect to claims 11 and 20, Hasegawa further teaches downloading said digital media file via a computer network (see Figure 1).

Claims 2, 5-7, 14-16, further recite forcing the user to viewed said advertisement before a predetermined portion of said has viewed a predetermined portion of said digital media. Corvin teaches making or forcing the user to watch the ads and not to let him or her fast forward or view a large amount of the media file without viewing the ads.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included forcing the user to viewed said advertisement before a predetermined portion of said advertisement has viewed a predetermined portion of said digital media in order to obtain cheating.

With respect to claims 8 and 17, Hasegawa further teaches that the advertisement data can be still image data, moving image or both (col. 9, lines 4-6).

Claims 9 and 18 further recite updating the advertising data in accordance with a user profile. Official Notice is taken that it is old and well known to collect user's profile such as purchases data and the like in order to present the user with a personalized ad or coupon that the user will most likely redeem based on his prior purchasing habits. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included updating the advertising data in accordance with a user profile in order to achieve the above mentioned advantage.

Claim 21 further recites storing the digital file locally, updating and preparing it for retail. Storing files locally updating them and preparing them for distributions are old and well known to make the file accessible and versatile for sale. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included storing the digital file locally, updating and preparing it for retail in order to achieve the above mentioned advantages.

Response to Arguments

1. The 101 has been withdrawn.

2. Applicant's arguments with respect to claims 1-3, 5-12, 14-21 have been considered but are moot in view of the new ground(s) of rejection.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
9/11/2009